

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 02/07/2011 has been entered.

Response to Arguments

2. Applicant's arguments with respect to claim 15 have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.

4. Considering objective evidence present in the application indicating obviousness or nonobviousness.
5. Claims **15-19** are rejected under 35 U.S.C. 103(a) as being unpatentable over MCI (WO 97/01253), in view of Shieh (US 6,591,098).

Re claim 15, MCI discloses a remote telecommunication system in a mobile telecommunication network, wherein the remote telecommunication system is configured for communicating with a subscriber identifying module, said remote telecommunication system storing (MCI, abstract: **the remote/network communicate with the old SIM card and the replacement SIM card**);

Deactivating the permanent account identifier attached to the second SIM (MCI: Abstract: **Disable (deactivate) the old SIM (second SIM) and enabling/activating the replacement SIM (first SIM)**);

Activating the another permanent account identifier attached to the first SIM (MCI: Abstract: **Disable (deactivate) the old SIM (second SIM) and enabling/activating the replacement SIM (first SIM)**);

a permanent account identifier which is activated and attached to a second SIM (MCI: Abstract: **Disable (deactivate) the (already activated) old SIM (second SIM) and enabling/activating the replacement SIM (first SIM)**); note, the two SIM cards in MCI are just/same SIM cards; therefore, are interchange/read as first or second card);

and treating an activation request including the account identifier, which is deactivated and attached to the first subscriber identifying module (MCI, abstract: the network/HLR/AUC receives/treats an activation request, including/treating the two permanent accounts identifiers in two SIM cards; wherein one SIM card is activated, and the other SIM card is deactivated; note, the two SIM cards are just/same SIM cards, therefore, are interchangeable/read as first or second cards), sent from an auto-activation application executed in the first SIM (MCI, abstract: when a replacement SIM card is inserted, it sends a auto-activation of the replacement SIM card to the network);

However, MCI doesn't specifically discloses:

activation request including the permanent account identifier and another account identifier, a one-time account identifier for a one-time logon of a first SIM to the network;

A set of instructions for accepting logon of the first SIM in the network with the one-time account identifier;

Shieh discloses:

activation request including the permanent account identifier and another account identifier (Shieh, the mobile sends out an activation/request to the network, the activation/request has two identifiers, i.e. S-ESN and another TAI identifier, see fig. 4 ref 202, TAI and S-ESN; C3 L1-35: see TAI, S-ESN, activation identifier, actual ESN); But doesn't specifically disclose one of the two identifiers is permanent; in a different embodiment, Shieh teaches the activation/request includes/transmits the permanent identifier (Shieh, C3 L30-35: see over-the-

air-activation and transmit the actual ESN; thus teaches an identifier is/easily a permanent/actual ESN);

a one-time account identifier for a one-time logon of a first SIM to the network (**Shieh: C3 L1-34, and C4 L29-44, Note: The SIM electronic Serial Number (S-ESN) is a temporary electronic serial number that is used in the registration and activation process (one-time usage));**

A set of instructions for accepting logon of the first SIM in the network (**Shieh, fig. 4-5: TAI and S-ESN are temporary, and they can be identified/accepted in the network)** with the one-time account identifier (**Shieh: C3 L1-34, and C4 L29-44: The SIM electronic Serial Number (S-ESN) is a temporary electronic serial number that is used in the registration and activation process (one-time usage));**

It would be obvious to one of ordinary skill in the art at the time the invention was made to modify MCI, and have (1) activation request including the permanent account identifier and another account identifier, (2) a one-time account identifier for a one-time logon of a first SIM to the network, (3) A set of instructions for accepting logon of the first SIM in the network with the one-time account identifier, as taught by Shieh, thereby will give user the advantage of activating a SIM based mobile device, using the identifiers (Shieh, abstract).

Re claim 16, MCI discloses:

wherein the remote telecommunication system is programmed for associating the permanent account identifier attached to the second subscriber identifying module with the same account as the account identified by the one-time account identifier attached to the first SIM (MCI: abstract, note: the first device with the replacement SIM card (new SIM) will replace the second device with the old SIM card (original SIM). Therefore, the new SIM card will identify as the same account as the old SIM card; note: “Administrator to correlate (associate) an identifier of the replacement SIM card with an identifier of the original SIM card”; note, one-time account in the SIM is disclosed in parent claim 15).

Re claim 17, MCI discloses wherein the remote telecommunication system is programmed for associating a permanent account identifier attached to the first SIM to an account which is different from the account identified by the permanent account identifier attached to the second SIM (MCI: abstract, note: the first device with the replacement SIM card (new SIM) will replace the second device with the old SIM card (original SIM). Therefore, the new SIM card will identify/associate as the same account as the old SIM card;

Re claim 18, MCI disclose: wherein the remote system determines the account identifier to be deactivated from the permanent account identifier attached to the second SIM as transmitted by the first SIM (MCI: Abstract, note: The old SIM card or previous permanent account identifier is to be deactivated, when/as the replacement SIM card uses the network for the first times, or when/as signal transmitted by the replacement SIM).

Re claim 19, Shieh discloses: wherein the one-time account identifier (Shieh: abstract, note: the one-time parameter could be an international mobile station identity (IMSI) and/or mobile identification number (MIN), and a temporary electronic serial number. MIN is a parameter, which is accompanied by a value (number)) is the same for a set of SIM in the network (Shieh, C1 L20-23, abstract, fig. 4; see identifiers, IMSI, MIN, TAI, S-ESN; the users/SIM(s) use the TAI and/or S-ESN; note that TAI is (same as) TAI);

It would be obvious to one of ordinary skill in the art at the time the invention was made to modify MCI, and have wherein the one-time account identifier is the same for a set of SIM in the network, as taught by Shieh, thereby will give user the advantage of activating a SIM based mobile device, using the identifiers (Shieh, abstract, C1 L20-23, fig. 4).

Allowable Subject Matter

6. Claims 8, 10, 12-13 and 20 are allowed.

Re claim 8, Shieh discloses a first SIM (subscriber identifying module) including a microcontroller in a mobile telecommunication network which is configured to communicate with at least one remote system in the mobile communication network (Abstract: A SIM card is inside a mobile device (SIM based mobile device). Said mobile device can communicate with the service provider (remote system) in the wireless network), said first SIM and said remote system being adapted to store at least one parameter identifying a user in the network (Abstract: SIM card stores subscriber info (parameter) for activation over the air with remote system), said first SIM comprising (Note: In abstract, the SIM card and mobile device are incorporated together as one object as a whole, and is regarded as SIM based mobile device);

a one-time account identifier designed for a one-time logon to the network (**Abstract: temporary activation identifiers, temporary electronic serial number**);

a permanent account identifier, said permanent account identifier being deactivated (**C3 L20-34: The actual electronic serial number (permanent account identifier) is currently deactivated until future registration**), and attached to the first subscriber identifying module (Shieh, abstract, C3 L1-35: see transmit the actual ESN in the future and overwriting the temporary activation identifiers; thus actual ESN and temporary ESN are attached to the first SIM);

and wherein said microcontroller is programmed to:

a) use the one-time account identifier to logon to the network when said first SIM is switched on (**Abstract: The temporary ESN, Fig5 ref 300**);

b) exchange the one-time account identifier with the permanent account identifier in the first SIM upon successful logon to the network as the active account identifier in the first SIM (**Abstract: Temporary activation identifier is overwritten (by the actual ESN); note, the exchange of the actual ESN occurs after the activation process**);

wherein the step b) is performed in said first SIM by an auto-activation application executed after receiving a message from the network (**Abstract: the network identifies the temporary**

electronic serial number and invokes an over-the-air activation) informing a successful
login (Abstract: After the mobile device has successfully logged into the network, said
login will be informed to the network device so that the activation can be performed,
therefore discloses informing a successful login);

MCI discloses:

another permanent account identifier, said another permanent account identifier being activated
and attached to a second subscriber identifying module (MCI, abstract, fig. 2: see
replacement/another permanent SIM card, said replacement SIM/identifier being activated
to a second/another SIM);

Tuilier discloses:

wherein the another permanent account identifier is copied from the second subscriber
identifying module to the first subscriber identifying module (Tuilier, single figure, C2 L26-40:
see to personalize a new SIM card which replaces the old SIM card, personalization
consists of transferring the directory file from the old SIM card to the new SIM card, and
the id/name for both the old and new SIM cards is "Pierre"; therefore, teaches Pierre
identifier is copied from a SIM card to another SIM card);

However, the combination of references fails to disclose:

wherein said one-time and another permanent account identifier are prestored in said at least one
remote system;

c) upon successful logon to the network, send an activation request including the permanent account identifier and the another permanent account identifier to said at least one remote network for deactivating in said at least one remote network the another permanent account identifier attached to the second subscriber identifying module;

Re claim 20, Shieh discloses a method for activating a SIM in a telecommunication network (**Shieh: Abstract, fig. 5: OAA or over-air-activation**), said method comprising the steps:

providing a first SIM which stores a one-time account identifier designed for a one-time logon to the network, a permanent account identifier, said permanent account identifier being deactivated (**Shieh: Column 3 lines 1 to 34 and column 4 line 29 to 44. Note: The SIM electronic Serial Number (S-ESN) is a temporary electronic serial number that is used in the registration and activation process (one-time usage); Column 3 lines 1 to 34 and column 4 line 29 to 44. Note: The actual electronic serial number (permanent account identifier) to the mobile device for future registration. The actual electronic serial number is currently deactivated until future registration**);

said first SIM being programmed to automatically, upon successful one-time logon to the network (**Shieh: Column 3 lines 1 to 34 and column 4 line 29 to 44. Before the final step, the network identifies the SIM electronic serial number as the temporary ESN associated with the mobile device, therefore, using the temporary ESN as the active account identifier, the mobile device is successfully logged on to the network, therefore discloses upon successful**

one-time logon to the network, first SIM being programmed to automatically invoke an activation), exchange the one-time account identifier with the permanent account identifier in said first SIM (Abstract: Finally, to complete the over-the-air-activation process, the method comprises setting the usage indicators to transmit the actual ESN in the future and overwriting the temporary activation identifiers, therefore discloses exchanging the one-time account identifier with the permanent account identifier in said first SIM; note, said logging on in the future with actual ESN is also “one-time logon in the future”);

MCI discloses:

Providing a remote network system which stores the another permanent account identifier attached to the second SIM, said remote network system being programmed for treating the activation request originating from the first SIM by the operations which include deactivating another permanent the account identifier attached to the second SIM and activating the account identifier attached to the first SIM **(MCI: Abstract, note: Disable (deactivate) the old SIM (second SIM) and enabling/activating the replacement SIM (first SIM));**

another permanent account identifier, said another permanent account identifier being activated and attached to a second subscriber identifying module (MCI, abstract, fig. 2: see replacement/another permanent SIM card, said replacement SIM/identifier being activated to a second/another SIM);

Truilier discloses:

wherein the another permanent account identifier is copied from the second SIM to the first SIM (Tuilier, single figure, C2 L26-40: see to personalize a new SIM card which replaces the old SIM card, personalization consists of transferring the directory file from the old SIM card to the new SIM card, and the id/name for both the old and new SIM cards is "Pierre"; therefore, teaches Pierre identifier is copied from a SIM card to another SIM card);

However, the combination of references fails to teach:

send an activation request including the permanent account identifier and the another permanent account identifier to a remote network system for activating said permanent account identifier attached to the first SIM;

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MUNSOON CHOO whose telephone number is (571)270-7140, fax number is (571)-270-8140 and email is munsoon.choo@uspto.gov. The examiner can normally be reached on Monday through Friday 7:30am to 5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nick Corsaro can be reached on (571)272-7876. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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